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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants :	Nobuyuki KOBAYASHI et al.	Group Art Unit: 2615
Appln. No. :	09/910,849	Examiner: Daniel R. Sellers
Filed :	July 24, 2001	Confirmation No.: 4815
For :	DIGITAL RECORDING AND REPRODUCING APPARATUS	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria VA 22314

Sir:

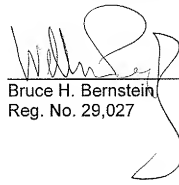
Applicants hereby request review of the final rejection of claims 1-16 dated June 2, 2006 in the above-identified application. No amendments are being filed with the request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached five sheets of *Attachment A*.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Nobuyuki KOBAYASHI et al.



Bruce H. Bernstein
Reg. No. 29,027

William Pieprz
Reg. No. 33,630

November 29, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

ATTACHMENT: A

The following is Applicants' statement pointing out clear errors in the Examiner's rejections and the Examiner's omissions of one or more essential elements needed for a *prima facie* rejection:

I. Claims 1, 2, 5 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over TANAKA. In this regard, **the rejections of claims 1, 2, 5 and 8 are clearly erroneous because the rejections fail to establish *prima facie* obviousness by failing to show that all claim limitations are taught or suggested by the prior art**. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *See* also MPEP §2143.03. Further, **the rejections are *prima facie* erroneous since the rejections do not provide reasons why one of ordinary skill in the art would have been motivated to combine multiple embodiments of TANAKA as set forth, for example, in the Final Office Action** (*see e.g.*, page 4 of the Final Office Action of June 2, 2006, where the rejection of claim 1 relies on the first and fourth embodiments in TANAKA; or page 3 of the Advisory Action mailed November 3, 2006, where the rejection relies on five distinct embodiments).

For example, claim 1 is drawn to a digital recording and reproducing apparatus that includes provisions **(A)** through **(D-3)** – as shown below in reproduced claim 1. The outstanding rejections do not establish that the prior art shows or suggests, *inter alia*, at least provisions **(B)**, **(D-1)**, or **(D-3)**, let alone a combination of all three provisions.

1. A digital recording and reproducing apparatus which is capable of having a
(A) removable external memory mounted therein, for performing recording of recording data in the external memory and reproduction based on the recording data recorded in the external memory,

the digital recording and reproducing apparatus comprising:

(B) an identification data-generating block that generates identification data that identifies the external memory individually;

(C) an internal memory in which the identification data can be recorded; and

(D-1) a control block that records the identification data in the external memory and said internal memory,

and carries out identification data determination processing that determines, when
(D-2) mounting of the external memory is detected, whether or not the identification data recorded in the external memory and the identification data recorded in said internal memory are identical to each other,

and to display a message that notifies that a different external memory has been
(D-3) mounted when the identification data are different from each other.

An object of the present invention is to distinguish between an initially mounted external memory and another subsequently mounted external memory. For example, during recording of data in an initially mounted external memory, if the initially mounted external memory is removed and replaced with a subsequently mounted external memory, the present invention is provided to prevent recording from proceeding in the subsequently mounted memory.

TANAKA, on the other hand, is primarily concerned with providing a memory system for ensuring protection of copyrights when a flash memory card, for example, is used. *See e.g.*, column 2, lines 6-8, TANAKA. TANAKA teaches at least twelve distinct embodiments for carrying out the memory system – many of the features of the twelve embodiments being mutually exclusive. TANAKA does not teach or suggest the afore-noted claim provisions **(B)**, **(D-1)**, or **(D-3)**.

Contrary to the Examiner's assertions, TANAKA does not individually identify an external memory, as required, for example, by provision **(B)** of claim 1. In fact, a core requirement of TANAKA is for numerous memory devices to have the same exact identification information (*see e.g.*, column 8, lines 40-44) in order for the system apparatus SYS1 to function. TANAKA is not concerned with identifying an individual external memory, but is instead concerned with identifying whether data has been copied and/or whether the system apparatus is configured to access specific data stored on a flash memory (*see e.g.*, TANAKA at column 8, lines 40-44; or column 9, lines 7-41).

At page 4 of the outstanding Final Office Action of June 2, 2006, the rejection references column 8, lines 21-30, and column 11, line 51 to column 12, line 10 of TANAKA to teach provision **(B)**. However, the cited excerpts describe two separate and distinct embodiments, each

of which prevents or restricts data access where the system apparatus SYS1 in the first embodiment, or SYS2 in the second embodiment, judges the identifying data to differ from that which the system apparatus is configured to access. *See e.g.*, column 8, lines 40-44 and column 10, lines 3-13, TANAKA. In both embodiments, TANAKA is concerned with identifying data and the source of the data, not an individual external memory on which the data has been stored. In TANAKA, millions of flash memories may have the same exact identifying information (*see e.g.*, column 8, lines 1-8), unlike provision **(B)** of claim 1, which requires an external memory to be identified individually. Thus, TANAKA does not teach or suggest at least provision **(B)** of, for example, independent claim 1.

Further, the above-noted rejections are erroneous because TANAKA does not teach or suggest, *inter alia*, provision **(D-1)** of, for example, independent claim 1. In the first embodiment, TANAKA teaches that software that changes the identifying information of the system apparatus may be stored in the memory card. TANAKA also teaches that software that changes the identifying information of the memory card may be stored in the system apparatus. *See e.g.*, column 7, line 65 *et seq.* Nevertheless, TANAKA does not teach that both the identifying information of the system apparatus and the identifying information of the memory card may be stored in the memory card and the system apparatus. In other words, TANAKA does not teach that it is possible to combine a technology that stores the identification data in the internal memory and a technology that stores the identification data in the external memory.

Moreover, a review of TANAKA's second through twelfth embodiments also reveals that TANAKA does not teach or suggest a single technology that records the identification data in the external memory and the internal memory as claimed in claim 1. Thus, TANAKA does not teach or suggest, *inter alia*, provision **(D-1)** of, for example, independent claim 1.

Further, the above-noted rejections are erroneous because TANAKA does not teach or suggest, *inter alia*, provision **(D-3)** of, for example, independent claim 1. In the outstanding Final Office Action of June 2, 2006, it appears that the rejection of claim 1 concedes that the first embodiment of TANAKA does not teach **(D-3)**. The rejection refers to the fourth embodiment

to teach **(D-3)**. Contrary to the assertion made in the rejection, "Tanaka's forth embodiment teaches a construction where a message that notifies a different external memory is mounted is displayed" (*see e.g.*, page 3 of Advisory Action mailed November 3, 2006), TANAKA's forth embodiment merely states that due to a defective mark that is intentionally attached to the Data Status Area, data is judged to be broken (not normal) and a message, "an error found in the drive", is displayed. However, the message, "an error found in the drive", is not only displayed when the defective mark is intentionally attached, but also when a memory card is not properly mounted in the system apparatus. Therefore, seeing the message "an error found in the drive", a person having ordinary skill in the art would not have concluded that "the message is displayed because a different memory has been mounted." The rejection does not provide a reason why one of ordinary skill in the art would have been motivated to modify TANAKA to "display a message that notifies that a different external memory has been mounted when the identification data are different from each other", as recited in, for example, claim 1. Thus, TANAKA does not teach or suggest the claimed subject matter of, for example, provision **(D-3)** of claim 1.

Next, it is evident (*see e.g.*, pages 3 and 4 of the Advisory Action mailed November 3, 2006; or page 4 of the Final Office Action of June 2, 2006) that the rejections are impermissibly picking and choosing features from at least five distinct embodiments of TANAKA, many of which are mutually exclusive, in attempting to reject the claimed subject matter of, for example, claim 1. Besides the fact that many of the features of the embodiments are mutually exclusive, the rejections do not provide any evidence why one of ordinary skill in the art would have been motivated to combine the various embodiments, much less any specific details on how the embodiments may have been combined, if at all possible. The Examiner's reference to TANAKA's disclosure at column 47, lines 47-52 to show that the embodiments can be combined is incorrect (*see e.g.*, page 3 of the Final Office Action). At column 47, lines 47-52, TANAKA merely states that "the invention can be realized in other various modes." Thus, the rejections have not provided a *prima facie* case of obviousness and should therefore be withdrawn.

Since claims 2, 5 and 8 depend from claim 1, directly or indirectly, and are patentably distinguishable for at least the reasons provided above with respect to claim 1, as well as for additional reasons related to their own recitations, the rejections are also clearly erroneous as to these claims.

II. Claims 3, 4, 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over TANAKA in view of KUBO. Further, claims 6, 7, 11 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over TANAKA in view of PAWLOWSKI. Further, claims 12, 13, 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over TANAKA in view of KUBO, and further in view of PAWLOWSKI. In this regard, KUBO and/or PAWLOWSKI fail to cure the shortcomings of TANKA, as discussed above with respect to claim 1. Since claims 3-4, 6-7 and 9-16 depend from claim 1, directly or indirectly, and are patentably distinguishable for at least the reasons provided above with respect to claim 1, as well as for additional reasons related to their own recitations, the rejections are also clearly erroneous as to these claims.

In conclusion, Applicants have shown the rejections of claims 1-16 to be clearly erroneous for at least the reasons that (1) the rejections fail to establish *prima facie* obviousness by failing to show that all claim limitations are taught or suggested by the prior art, and (2) the rejections are *prima facie* erroneous since no reasons have been provided why one of ordinary skill in the art would have been motivated to combine multiple embodiments of TANAKA as set forth in the outstanding Final Office Action. Thus, Applicants request that all outstanding rejections be withdrawn and the application be allowed to issue, including claims 1-16.